

### REMARKS/ARGUMENTS

Favorable reconsideration of this application, as presently amended and in light of the following discussion, is respectfully requested.

Claims 24-26 have been withdrawn from further consideration as being drawn to a nonelected species, Claims 17-23 and 27-32 have been rejected under 35 U.S.C. §112, second paragraph, as being vague and indefinite; Claims 17, 18, 20-21, 23 and 27-32 have been rejected under 35 U.S.C. §103 as being unpatentable over WO97/14326 (hereinafter Polegato); Claim 19 has been rejected under 35 U.S.C. §103 as being unpatentable over Polegato in view of Cheng and Claim 22 has been rejected under 35 U.S.C. §103 as being unpatentable over Polegato in view of Rauch. Claims 24-26 have been canceled, without prejudice, while new Claims 33 and 34 have been added and thus, Claims 17-23 and 27-34 remain active.

Considering first then the Examiner's rejection of Claims 17-23 and 27-32 under 35 U.S.C. §112, second paragraph, as being vague and indefinite, it is to be noted that the phrase "at least in a preset macroportion" and "at least one through macroperforation of said at least one preset macroportion made of net, felt or other diffusely perforated material" has been indicated as being unclear insofar as the Examiner does not understand the meaning of "preset macroportion". In this regard, it is to be noted that the discussion at page 4, lines 25-26 specifies that the term "macroportion" is used to reference portions of area preferably on the order of at least one square centimeter. Thus, the phrase "preset macroportion" would be a preset or predetermined macroportion of the support layer 10 having macroportions 11 as discussed at page 4, lines 19-20 which indicates that, with reference to Figures 1-4, a waterproof and breathable sole for shoes has, in a first embodiment a structure that comprises a supporting layer which is made of net, felt or other diffusely perforated material in preset

macroportions 11. Thus, not only is the terminology explained in the specification but such is also properly illustrated such that, it is submitted, one of ordinary skill in the art would clearly understand the meaning of the above-noted terminology. In view of this and in view of the fact that Applicant is permitted to be his own lexicographer when describing his invention, as clearly supported by court decisions, it is submitted that the language of Claims 17 and 32 should be determined to be acceptable under 35 U.S.C. §112.

With regard to the Examiner's comment regarding Claim 21 that the support layer does not have any macroportion, it is submitted that the above-noted terminology and the discussion at page 4, lines 19-22 indicates otherwise and that full support of that portion of the application and the claims as originally filed support this conclusion. With regard to Claim 21 and the support layer being covered by the membrane and the tread as being inaccurate, it is to be noted that both the specification as well as Figures 6 and 7 show that the support layer 10 is covered by a membrane 13. In addition, the location of the tread has now been amended in Claim 21 to indicate that the tread is connected to the supporting layer.

With regard to the Examiner's comments regarding Claim 23, it is to be noted that Claim 23 depends from Claim 18 which includes the language stating that the at least one preset macroportion is made of net, felt or other diffusely perforated material. Insofar as this provides for claim protection with regard to the substitution of any equivalent structure, it is submitted that including this language in the claim is necessary to properly protect Applicant's invention. In view of the foregoing, favorable reconsideration of the claims under 35 U.S.C. §112 is believed to be in order and the same is hereby respectfully requested.

Considering next then the rejection of Claims 17, 18, 20-21, 23 and 27-32 as being unpatentable over Polegato, the rejection of Claim 19 under 35 U.S.C. §103 as being unpatentable over Polegato in view of Cheng and the rejection of Claim 22 under 35 U.S.C.

§103 as being unpatentable over Polegato in view of Rauch, it is to be noted that each of Claims 17 and 32 have been amended to state that the supporting layer has, at least in a preset macroportion thereof in an area on the order of at least one square centimeter (as supported in the original specification at page 4, lines 27-28) and also includes the limitation that the at least one through macroperforation exposes the supporting layer to the exterior of the tread at least in one preset macroportion having an area on the order of at least one square centimeter as also discussed in the specification and as illustrated in the figures. In this regard, it is noted that the exposure of the supporting layer to an area outside the tread at the macroportion by the macroperforation is clearly illustrated in the figures as originally filed and would be recognizable to one of ordinary skill in the art. Moreover, one of ordinary skill in the art, when presented with the discussion at page 2, lines 15-27 as to the drawbacks of the known prior art according to which the “macroperforations in any case limits the area of the membrane that is actually affected by the exchange of heat and vapor”, and thereafter at page 8, lines 9-10 according to which the structure of the disclosed invention “allows to enlarge the area of the membrane until it affects substantially the entire sole of the foot”, would thus understand the advantages afforded by the present invention. Such explanations, taken together with the drawings and the detailed description thereof, provide clear support for the language added to the claim with respect to the limitation that the at least one through macroperforation exposes the supporting layer to the exterior of the tread at least at the at least one preset macroportion having an area on the order of at least one square centimeter.

With regard to the teachings and disclosures of Polegato, Cheng and Rauch, Applicant notes that none of the above-noted references teaches or discloses Applicant’s claimed invention as now set forth in Claims 17 and 32 or any of the claims dependent therefrom. More particularly, as described originally at page 2, lines 23-27 of Applicant’s specification,

the known prior art only discloses micro-perforations extending downwardly of the tread having a diameter on the order of 1-2 millimeters. Such micro-perforations tend to limit the area of the membrane that is actually affected by the exchange of heat and vapor. Polegato in fact disclose such limited dimension micro-perforations as being provided downwardly in the tread.

To the contrary, the present invention provides for macroperforations (16, 116) of the tread (15, 115) corresponding with the macroportions (11, 111) of the supporting layer (10, 110) for exposing the supporting layer (10, 110) at such macroportions (11, 111), which advantageously maximizes the breathability provided by the sole by allowing one to utilize to the fullest extent the breathability of the waterproof, vapor-permeable membrane by enlarging the area of the membrane over the sole of the foot (see page 8, lines 4-10).

Contrary to the present invention, Polegato as well as Cheng and Rauch only provide microperforations in the tread below the membrane on the order of about 1-2 millimeters, and offer no teachings or fair suggestions which would lead one having ordinary skill in the art to Applicant's claimed invention for providing these advantageous affects and which provide the advantages discussed above. In view of the foregoing, it is respectfully submitted that Claims 17 and 32 clearly patentably define over the prior art and thus merit indication of allowability.

Each of the claims dependent from Claims 17 and 32 also contain additional limitations not shown by the prior art. Applicant further notes that each of new Claims 33 and 34 specify that the at least one through portion of the tread extends through an entire thickness portion of the tread, unlike the perforations in Polegato and that the preset microportion (16, 116) of the support layer extends into at least one of the through portions of the tread, as clearly illustrated in Figures 1-3, 5-7 and as discussed in the specification. It is

therefore submitted that each of Claims 33 and 34 also patentably define over the prior art of record as well as the remaining references of record.

In view of the foregoing, an early and favorable Office Action is believed to be in order and the same is hereby respectfully requested.

Respectfully submitted,

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